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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/050,249	03/30/1998	HARUKI OKAMURA	OKAMURA=2B	6601

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EXAMINER	
JIANG, DONG	

ART UNIT	PAPER NUMBER
1646	

MAIL DATE	DELIVERY MODE
01/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/050,249	Applicant(s) OKAMURA ET AL.	
	Examiner Dong Jiang	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 93,95 and 98-120.

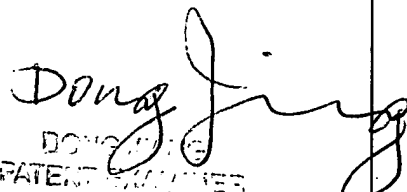
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See "Continuation of 7".
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.


 DONG JIANG
 PATENT EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 93, 95 and 98-119 under 35 U.S.C. 112, second paragraph, as being indefinite, in view of applicants amendment.

Continuation of 7.

Claims 93, 95 and 98-120 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (Infect. Immun. 61: 64-70, 1993), for the reasons set forth in the previous Office Actions.

Applicants argument filed on 12/19/07 has been fully considered, but is not deemed persuasive for reasons below.

Applicants repeated the arguments presented in the previous responses, on pages 8-11, that the prior art factor (by Nakamura) is different from that of Okamura (which is the same as that in the present application, cited by the examiner as supporting evidence) based on MW, purity and activity of the factor after SDS-PAGE. These arguments have been repeatedly addressed in detail in the previous Office Actions, and they are not persuasive for the reasons of record.

With respect to MW and purity (pages 8-9 of the response), applicants argue that besides teaching that "IGIF in the serum sample was proved to be the same IGIF as that found in the liver extract" (at page 3969 of the Okamura reference), Okamura also teaches: "...and it was considered to be bound to another protein or to exist in an oligomeric form", this clearly teaches that the IGIF disclosed in Okamura differs from the factor disclosed in Nakamura at least in its form as well as in its molecular weight, that Nakamura did not purify the factor and isolate IGIF because the factor lost its activity after SDS-PAGE (pages 9-10). This is not persuasive because, in the absence of evidence to the contrary, neither different physical forms nor purity of the same molecule would make the molecule itself different each from each other, and it is less relevant when either form of the molecule or less purified molecule is used for generating antibodies because same antibodies would be generated so long as the same antigen is used, and there is no requirement that an antigen has to be purified to homogeneity and possess the activity for the use of generating antibody.

With respect to the activity of the factor after SDS-PAGE (page 10 of the response), applicants argue that that Nakamura's factor did not possess its activity when purified from SDS-PAGE. This is not persuasive because lossing activity after SDS-PAGE does not indicate that Nakamura's factor differs from that of the present invention as it can be multiple reasons such as the use of reducing agent.

Finally, applicants argue, on pages 10-11 of the response, that Nakamura did not succeed in obtaining monoclonal antibodies to the factor at the time the reference was published, and what was disclosed in Nakamura was not sufficient to allow one of ordinary skill in the art to obtain monoclonal antibodies, even if the technology for making monoclonal antibodies was well established in the art at the time the present invention was made, accordingly, Nakamura cannot make obvious the presently claimed invention. This is not persuasive because one or two publications focusing on different issue (the factor) did not disclose the antibody to the factor is not the indication that one of ordinary skill in the art were not able to obtain monoclonal antibodies based on Nakamura's teaching of the polypeptide factor, and the well-established technique in the art in making monoclonal antibody. There is no showing that others of ordinary skill in the art were working on the problem, and there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited reference, they would still be unable to solve the problem.